

REMARKS

Claims 1-5, 8, 14, 16-17, and 36-37 remain rejected under 35 USC 112, first paragraph. The Examiner states that there no affidavit or declaration by the Applicant, or a statement by the attorney of record over his or her signature and registration number, stating that the seeds will be irrevocably and without restriction or condition released to the public upon the issuance of a patent. Applicant respectfully disagrees. On page 2 of Applicant's August 8, 2003 Reply, the specification was amended to recite all the deposit statement requirements pursuant to the Budapest Treaty. Applicant specifically amended the specification to state that the seeds will be irrevocably and without restriction or condition released to the public upon the issuance of a patent. This amendment was under Applicant's attorney's signature as required. Regardless, Applicant's Attorney makes the following statement.

Applicant has made a deposit of at least 2500 seeds of the cultivar of the present invention with the American Type Culture Collection (ATCC), Manassas, Virginia, 20110-2209 U.S.A., ATCC Accession Number NoPTA-5164. During pendency of this application, access to the invention will be afforded to the Commissioner by request; all restrictions upon availability to the public will be irrevocably revoked upon granting of the patent; the deposit of cultivar S52-U3 will be maintained in the ATCC depository, which is a public depository, for a period of 30 years, or 5 years after the most recent request, or for the effective life of the patent, whichever is longer, and will be replaced if it becomes nonviable during that period. Applicant has tested the viability of the deposit at the time of deposit. Applicant has satisfied all the requirements of 37 C.F.R. §§1.801-1.809. Applicant imposes no restrictions on the availability of the deposited material from the ATCC.

Claims 1-8, 14, 16-17, 36-37 stand rejected under 35 USC 103(b) as anticipated by or in the alternative, in the alternative, under 35 USC 103 as obvious over Rhodes (1999, US Patent 5,294,666).

Claims 1-35 stand rejected under 35 USC 102(b) as anticipated or, in the alternative, under 35 USC 103 as obvious over Luzzi (2000, US Patent 6,084,159).

The Examiner states, as a basis for both rejections, that the Examiner cannot determine whether the prior art possesses the "unrecited characteristics." The Examiner further states "where the prior art seems to be identical, except that the prior art is silent to a characteristic or

property claimed, then the burden shifts to Applicant to provide evidence that the prior art would neither anticipate nor render obvious the claimed invention. See *In re Best*, 195 USPQ 430 (CCPA 1977).” The Applicant respectfully submits that the Examiner has misstated the ruling set forth in *In re Best*, and has not sufficiently established that there is a sound basis for believing that the products of the applicant and the prior art are the same. *In re Spada* 15 USPQ2d 1655 (Fed. Cir. 1990). A correct analysis of *In re Best*, shows that in that case the Examiner’s rejection was based on the inherency doctrine:

Thus, the examiner’s conclusion that those parameters of the resultant product which are recited in the appealed claims but are not expressly disclosed in the reference would be inherent is a reasonable one, absent convincing evidence to the contrary. (562 F.2d at 6)

The court in *In re Best* goes on to state:

Additionally, where the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied upon. (562 F.2d at 8)

Thus, it is clear the Examiner must establish inherency before requiring that the Applicant prove that the subject feature is not inherent in the prior art. The Examiner, in this case, has not set forth a reasonable basis for inherency.

“Under the principles of inherency, if the prior art **necessarily** functions in accordance with, or includes, the claimed limitations, it anticipates” (*In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1349 (Fed. Cir. 2002). *Emphasize added*. The court in *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999), made it clear that inherency “may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” (cases enclosed)

As stated in the specification, the production of soybean cultivars having distinct genotypes is highly unpredictable. This unpredictability is because the breeder’s selection occurs in unique environments, with no control at the DNA level (using conventional breeding procedures), and with millions of different possible genetic combinations generated. A breeder cannot predict the final resulting lines he or she develops, except possibly in a very gross and

general fashion, and the breeder cannot produce the same cultivar twice by using the exact same origin parents and the same selection techniques.

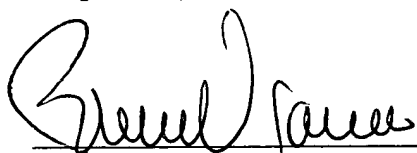
Neither '666 nor the '159 patent discloses that the cultivars disclosed therein were developed using the same ancestral materials that are in the background of soybean cultivar S52-U3. In addition, even if they were, it is undisputable that the inventors could not have produced the same cultivar. Those skilled in the art recognize that all maize soybean plants possess grossly similar characteristics. However, each soybean cultivar is characterized by a unique genotype that is different from all other soybean cultivars. Although conventional breeding techniques are known in the art, the results of such breeding, however, are unpredictable. Applicant respectfully submits that the basic nature of the claimed subject matter necessitates that the claimed subject matter is patentably different.

Clearly, based on the nature of the claimed soybean cultivar S52-U3, the Examiner has not shown that the "prior art **necessarily** functions in accordance with or includes the claimed limitations," but has merely concluded that there is a probability or possibility of inherency. Therefore, Applicant respectfully requests that the Examiner withdraw her rejections based on 35 USC 102(b) and 35 USC 103.

Applicant respectfully submits that the claimed cultivar S52-U3 is patentably different from both soybean cultivars 9392379531283 and 9524889614923 and that the '159 the '666 patents, when taken alone or together, do not anticipate the claimed invention nor make the claimed invention obvious.

In view of the above amendments and remarks (and the remarks set forth in Applicant's August 8, 2003 Reply), it is submitted that the application is ready for allowance. If any additional information is needed, the Examiner is invited to call the undersigned attorney at (919) 541-8614.

Respectfully submitted,


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